REMARKS

Claims 11-30 are currently pending in the present application. The Examiner has indicated that claims 12, 13, 15, 17 and 23 are withdrawn from consideration.

The Original Election Requirement

In Paper No. 8, the Examiner required the election of a single invention for examination and prosecution on the merits. More specifically, the Examiner required that "applicants must elect one ultimate mixture for examination." (*See,* Paper No. 8, p. 2). The Examiner contended that the application contains claims directed to "plural compositions comprising a mixture of two or more different compounds." (*See, id.*). The Examiner also contended that "[e]ach mixture constitutes a unique special technical feature because each compound possesses unique properties based on its structure." (*See, id.*). The Examiner also noted that "[t]he compounds are specified as a1, a2, a3 and a4 in claim 1." (*See, id.*). Finally, the Examiner also required that "[i]f applicants elect a3 as one of the components of the mixture one ultimate a3 must be elected from claim 22." (*See, id.*). On the basis of the foregoing arguments and contentions, the Examiner required the election of a "single mixture".

In the current Office Action, the Examiner deems the Requirement "proper" and makes it final. The Examiner dismisses Applicants' argument that "groups of claims must be provided." (*See,* the Office Action, p. 2). The Examiner simply states that, "the restriction requirement here constituting elections of species, are within a group. . . . [t]hus, the cited rule does not apply." (*See, id.*).

Traversal of the Original Restriction Requirement and Request for Reconsideration

Applicants again respectfully traverse the original election requirement for the following reasons.

First, the Examiner is incorrect as to the applicability of 37 C.F.R. §1.499. It is clear and well-settled that PCT Unity of Invention practice applies to U.S. national applications

filed under 35 U.S.C. §371. U.S. patent applications based upon national stage filings of PCT applications designating the U.S. are examined under PCT rules for Unity of Invention, not ordinary restriction practice. As set forth in the M.P.E.P., "Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage (filed under 35 U.S.C. 371) applications." (*See*, M.P.E.P., 8th Edition, Revision 1, §1893.03(d)).

Section 1893.03(d) of the M.P.E.P., 8th Edition, Revision 1, clearly explains 37 C.F.R. §1.499, which governs **Unity of Invention** during the national stage, while making no distinction between "restriction" and "species election", as follows: "[w]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of *claims* and (2) explain why each group lacks unity with each other group (*i.e.*, why there is no single general inventive concept) specifically describing the unique special technical feature in each group." (*See*, M.P.E.P. §1893.03(d), (*emphasis added*)).

Unity of Invention practice does not make a distinction between "restriction" and "species election" practice because Unity of Invention is based upon the presence or absence of a common special technical feature among the several inventions, not the "separate and distinct" criteria upon which ordinary U.S. restriction and species election practice are based.

Applicants submit that despite the Examiner's unsupported legal conclusion to the contrary, 37 C.F.R. §1.499 does, most certainly, apply to the alleged legal substantiation for the Examiner's Election Requirement. In order for the Examiner to legally require an election of a single invention in the instant §371 national stage application, the Examiner must follow the criteria set forth in 37 C.F.R. §1.499.

The Examiner has not identified any groups of claims which allegedly constitute separate inventions. Moreover, the Examiner has not explained how any one group of claims lacks unity with another group of claims. The Examiner has simply argued that "each compound possesses unique properties based on its structure." The Examiner then concludes based upon this argument, that each mixture constitutes a unique special technical feature. The Examiner's

arguments and conclusion are flawed in many respects and are incorrect with respect to a determination of Unity of Invention.

One embodiment of Applicants' claimed invention is directed to cosmetic preparations comprising:

(a) a mixture of two or more surfactants selected from the group consisting of (a1) fatty acid (polyglycol) esters, and (a2) fatty alcohol (polyglycol) ethers, and at least one component selected from the group consisting of (a3) polyols and (a4) alk(en)yl oligoglycosides, the mixture present in an amount of from 30 to 70% by weight; and

(b) one or more oil components in an amount of from 70 to 30% by weight; said percentages by weight based upon a total weight of the mixture and the one or more oil components.

Thus, in each claimed cosmetic preparation, a mixture of two or more surfactants selected from (a1) fatty acid (polyglycol) esters and (a2) fatty alcohol (polyglycol) ethers is present along with at least one component selected from (a3) polyols and (a4) alk(en)yl oligoglycosides. **This special technical feature which all of the present claims have in common, –at least two selected from (a1) and (a2) along with at least one selected from (a3) and (a4)–, unites all of the alleged separate inventions claimed in the instant application.**

The law requires the Examiner to identify groups of claims and explain why each group lacks unity of invention with the others. The Examiner has NOT identified any separate groups of claims. In fact, it appeared that the Examiner had treated all of the claims as one group. Independent claim 11 and each of those claims dependent therefrom, *i.e.*, claims 12-28, as well as independent claims 29 and 30, each recite at least two surfactants selected from (a1) and (a2) along with at least one component selected from (a3) and (a4).

In the current Office Action, the Examiner has indicated that claims 12, 13, 15, 17 and 23 are withdrawn from consideration. However, this does not shed any useful light on the matter of grouping the claims in view of Applicants' provisional election, with traverse, presented in response to Paper No. 8. In response to Paper No. 8, Applicants provisionally elected a cosmetic composition comprising: (a) a mixture of at least one fatty acid (polyglycol)

ester, at least one fatty alcohol (polyglycol) ether, and at least one alkylene glycol, the mixture present in an amount of from 30 to 70% by weight; and (b) one or more oil components in an amount of from 70 to 30% by weight; said percentages by weight based upon a total weight of the mixture and the one or more oil components, with traverse, for prosecution on the merits.

Claim12, which requires the presence of a fatty acid (polyglycol) ester and one or more components selected from the group consisting of fatty alcohol (polyglycol) ethers and alk(en)yl oligoglycosides, *but which is dependent upon claim 11*, arguably still reads upon the provisionally elected invention. Based upon claim 11, wherein the composition includes (a) a mixture of at least one fatty acid (polyglycol) ester, at least one fatty alcohol (polyglycol) ether, and at least one alkylene glycol, **(as provisionally elected)**, claim 12 could simply be read to allow for the *further inclusion of an alk(en)yl oligoglycoside*. Claim 13, which requires the presence of a fatty acid (polyglycol) ester and one or more components selected from the group consisting of fatty alcohol (polyglycol) ethers and polyols, also appears to read on the provisionally elected invention. Yet, the Examiner has withdrawn these claims from consideration. Also dependent upon claim 11, and assuming for the sake of argument that we begin with the "provisionally elected invention", claim 15 simply requires the presence of an alk(en)yl oligoglycoside.

This exercise addressing the dependent claims is not in any way intended to imply that the claimed invention requires the presence of a polyol, but is simply included to highlight the improper withdrawal of these dependent claims from consideration by the Examiner. As mentioned above, the claimed invention is directed to cosmetic compositions which contain the claimed amount of a mixture that includes at least one component selected from (a3) polyols and (a4) alk(en)yl oligoglycosides. In other words, at least one polyol OR one alk(en)yl oligoglycoside. On the basis of the Examiner's legally unfounded Requirement, Applicants' have provisionally elected, with traverse, those embodiments wherein a polyol is present.

With respect to withdrawn claim 17, Applicants submit that here too, the claim reads on the elected embodiment by further incorporating at least one alk(en)yl oligoglycoside.

Finally, claim 23 simply provides a class of alk(en)yl oligoglycosides from which the alk(en)yl oligoglycoside recited in claim 11 may be chosen.

Thus, not only is it difficult to understand why the Examiner has withdrawn these claims from consideration, it still remains difficult, if not impossible, to determine which claims the Examiner has grouped separately from any other group of claims.

Even if one were able to determine how the Examiner has decided to group the claims, the Examiner has absolutely failed to provide any explanation as to why any one group of claims lacks unity with another group of claims. No groups have been identified. The Examiner has argued that "each mixture constitutes a unique special technical feature because each compound possesses unique properties." This argument is deficient as a matter of law as explained in the following paragraph. The inventive mixtures must be considered as a whole, not on the basis of different individual components.

The various divergent properties of different compounds contained in an inventive mixture do not create various special technical features. Under the law, the term "special technical feature" has a specific meaning. Pursuant to PCT Rule 13.2, the Examiner must consider each invention as a whole with respect to "special technical features". PCT Rule 13.2 states that,

> [w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, *considered as a whole*, makes over the prior art. (Patent Cooperation Treaty, Rule 13.2 (*emphasis added*)).

Thus, Applicants submit that it is the technical feature which all of the claims have in common, *i.e.*, the "at least two selected from (a1) and (a2) along with at least one selected from (a3) and (a4)", that unites all of the claimed inventions. Accordingly, Applicants respectfully submit that all of the pending claims relate to a single general inventive concept under PCT Rule 13.1, namely the cosmetic preparations containing the claimed amount of oil

component and the claimed amount of the mixture of at least two selected from (a1) and (a2) along with at least one selected from (a3) and (a4). Moreover, PCT Rule 13.4 specifically allows multiple dependent claims to particular embodiments which could be considered to be a separate invention.

Finally, Applicants respectfully note that the PCT authorized officer who handled the instant application during the international stage did not have an objection based upon unity of invention.

Therefore, Applicants respectfully submit that the election requirement of a single disclosed invention for prosecution on the merits is improper, and again request reconsideration by the Examiner, withdrawal of the original election requirement, and concurrent prosecution on the merits of all pending claims and subject matter embodied therein.

The Election Requirement in the current Office Action

In the current Office Action, the Examiner has required further election "between fatty acid glycol esters and fatty acid glycol esters." (*See*, the current Office Action, p. 2). The Examiner has also required further election "between fatty alcohol ethers and fatty alcohol (polyglycol) ethers." (*See, id.*)..

Traversal of the Further Requirement set forth in the current Office Action

Applicants respectfully traverse the further election requirement set forth in the current Office Action for essentially the same reasons set forth above with respect to the original requirement. No groups have been identified and no argument has been presented as to how anyone claim lacks a corresponding special technical feature as compared to another claim.

Provisional Election With Traverse

In the event the Examiner does not find Applicants' arguments with respect to the withdrawal of the further election requirement persuasive, and the Examiner maintains the election requirement set forth in the current Office Action, Applicants provisionally elect fatty

acid polyglycol esters and fatty alcohol (polyglycol) ethers, with traverse, for prosecution on the merits.

Respectfully submitted,

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(Date)

By: _____

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